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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,904	05/04/2001	David L. Tennent	SP01-117	8708

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EXAMINER

VINCENT, SEAN E

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,904

Applicant(s)

TENNET ET AL.

Examiner

Sean E Vincent

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-20 and 22-33 is/are rejected.
- 7) ☒ Claim(s) 3 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: page 7, lines 23 and 24 contain a blank reference to another US application.

Appropriate correction is required.

### ***Claim Objections***

2. Applicant is advised that should claim 18 be found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 and 33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the listed perfluorinated groups (page 4, line 24), does not reasonably provide enablement for all of the numerous possible perfluorinated groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is

Art Unit: 1731

most nearly connected, to use the invention commensurate in scope with these claims. It is the position of the examiner that "perfluorinated groups" reads on an infinite number of perfluorinated hydrocarbon structures. Further the terms "chloro-derivative" and "fluoro-derivative" are broader in scope than "perfluorinated group".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is confusing because the selection of  $\text{CF}_3$  or  $\text{C}_2\text{F}_5$  as  $\text{R}_\text{F}$  would result in a chloro-derivative containing precursor that contained no chlorine.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-11, 14-20, 22-27, 29-31 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rau et al (US 4162908). The features of applicant's claims can be found in the figures, col. 2, lines 56-59; col. 3, lines 15-35; col. 4, lines 16-50 and the claims. It is the position of the examiner that "silica precursor comprising a perfluorinated group" reads on perfluorinated silanes. There is no apparent requirement in the claims for carbon atoms in the precursor compounds.

9. Claims 12 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by figure 2 of EP 0208086 A1.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rau et al in view of Guerder et al (US 4367013).

13. Rau et al does not teach delivering other metal oxide precursors to the conversion site. Guerder et al taught similar silica deposition with fluorine doping and included titania precursors to produce titania and fluorine doped silica (see abstract and col. 4, line 63 to col. 5, line 49 as well as col. 7, line 56 to col. 8, line 8). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include titania precursors at the conversion site of

Rau et al because Guerder et al taught in col. 1, lines 28-36 that germanium, boron, titanium and aluminum oxide doping was well known in the art for adjusting the refractive index of silica.

*Allowable Subject Matter*

14. Claims 3 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claim 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest methods for making silica as claimed using silica precursors satisfying one of the following conditions:

- a. The precursor is represented by  $\text{Si}(\text{OR}_F)_x\text{F}_{4-x}$  wherein  $\text{R}_F$  is the perfluorinated group and  $x$  is an integer from 1 to 4.
- b. The precursor is one of  $\text{Si}(\text{R}_F)_4$  or  $\text{Si}(\text{OR}_F)_4$  wherein  $\text{R}_F$  is one of  $\text{CF}_3$ ,  $\text{CClF}_2$ ,  $\text{CCl}_2\text{F}$ ,  $\text{CCl}_3$  and  $\text{C}_2\text{F}_5$ .

It would not have been obvious to use such precursors in the prior art methods.

*Conclusion*

17. The prior art made of record and not relied upon is cited to further show the state of the art.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is 703-305-3607. The examiner can normally be reached on M - F (8:30 - 6:00) Second Monday Off.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.
20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Sean E Vincent  
Primary Examiner  
Art Unit 1731